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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/385,802	08/30/1999	KEVIN REMINGTON JOSEPH BARTHOLOMEN DONOVAN	4031/1	9671
23446	7590	03/23/2005	EXAMINER	
MCANDREWS HELD & MALLOY, LTD 500 WEST MADISON STREET SUITE 3400 CHICAGO, IL 60661			FLYNN, KIMBERLY D	
			ART UNIT	PAPER NUMBER
			2153	

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/385,802

Applicant(s) :BARTHOLOMEN DONOVAN,
KEVIN REMINGTON JOS**Examiner**

Kimberly D Flynn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-20,22 and 103 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-20,22 and 103 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to a Request for Continued Examination filed January 20, 2005. Claims 17-20, 22 and 103 are presented for further consideration.

Affidavit Filed under 37 CFR 1.131

2. The Declaration filed on November 15, 2004 under 37 CFR 1.131 has been considered but is ineffective to overcome the Auerbach reference.

In particular the declaration includes a press release that describes Prodigy Communications Corporation's plans to release an instant messaging product that is compatible with multiple IM platforms such as IRC and AOL. The press release is a broad statement about a product that prodigy plans to debut, but not describe any particular steps or limitations of the instant application. While the press release discloses that the product will allow subscribers to send and receive instant messages with users of multiple chat platforms simultaneously these functions could have been carried out in different ways. The press release does not describe any of the particular limitations or steps required to perform the aforementioned functions.

In particular independent claim 1, calls for a method of conducting an instant messaging session between a first user and a second user over the Internet, the users being associated with two different realms, each realm being accessible via the Internet using a protocol characteristic to the realm, each user getting access to the Internet via a respective first and second device, at least one device having a storage media for storing the characteristic protocol of the other realm, the method comprising the steps of:

determining a current IP address of the second user, and establishing a connection from the first and second users using the current IP address and the characteristic protocol.

There is no description of the steps of determining a current IP address of the second user, and establishing a connection from the first and second users using the current IP address and the characteristic protocol as required by claim 1. The preamble of the claim which is most related to the press release is only connected to the body of the claim by the use of the characteristic protocol. Because the preamble is not given any patentable weight, and the declaration does not support the limitations of the body of the claims, there is not sufficient evidence that the Applicant had possession of the particular steps of the invention prior to the filing date of Auerbach.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

4. Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- In considering claim 16, the limitation stating the following: “determining a current IP address of the second user, and establishing a connection from the first and second users using the current IP address and the characteristic protocol” is ambiguous. It is not clear as to who is performing these steps.

- In considering claim 16, the claim states the limitations "the characteristic protocol" in line 5 and "said characteristic protocol" in line 9 of the claim. There is insufficient antecedent basis for these limitations in the claim.
- Claims 17-20, 22, and 103 depend from claim 16 and are rejected as well.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 16 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Auerbach (U.S. Patent NO. 6,549,937 hereinafter Auerbach) in view of Kim (U.S. Patent No. 6,490,274; hereinafter Kim).

In considering claim 16, Auerbach discloses a method of conducting an instant messaging session between a first user and a second user over the Internet, the users being associated with two different realms, each realm being accessible via the Internet using a protocol characteristic to the realm (col. 2, lines 19-28), each user getting access to the Internet via a respective first and second device (fig. 3, client 102), at least one device having a storage media for storing the characteristic protocol of the other realm (see fig. 3, protocol services 130, and 132) the method comprising the steps of:

While Auerbach discloses the user logging on to the primary service provider using established logon procedures, Auerbach is not specifically disclose the steps of determining a

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current IP address of the second user, and establishing a connection from the first and second users using the current IP address and the characteristic protocol. Nonetheless the aforementioned steps are well known in the art as evidenced by Kim.

In similar art, Kim discloses a peer-to-peer telephony system for supplying service using a cable network that discloses when a first or second cable phone initiates a call, the network segment units each have a head end unit that read IP addresses stored in the directory unit based on a received telephone number of a second cable phone and determines a session using an Internet protocol from the read IP addresses to set a call path with the first cable phone (see Kim, abstract and col. 4, lines 56-65). It would have been obvious to modify the system disclosed by Auerbach to include the connection steps taught by Kim in order to allow the user to connect to and engage particularly in instant messaging sessions regardless of their different protocol or service providers used. Therefore, the limitations would have been an obvious modification to the system disclosed by Auerbach.

In considering claim 22, Auerbach discloses displaying a window on the screen of the first and second devices, the window indicating a list of active users (see Fig 4B).

7. Claims 17-20 and 103 are rejected under 35 U.S.C. 103(a) as being unpatentable over Auerbach (U.S. Patent NO. 6,549,937) in view of Appelman; (U.S. Patent No. 6,750,881).

In considering claim 17, while the combined system of Auerbach and Kim discloses the system substantially as claimed, it does not disclose that each time one of the first and second users access the Internet, the corresponding device sends a message to an IM database indicating

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the corresponding user is online and the current IP address. Nonetheless, the aforementioned limitation is a well-known feature of instant messaging systems as evidenced by Appelman..

In similar art, Appelman discloses a real time notification system that tracks, for each user, the logon status of selected co-users. Appelman further discloses that when a user logs on the logon system notifies the Buddy List System about the user (i.e. passes the User's ID, address, or screen name to the Buddy List System) (see Appelman col. 6, lines 57-59). It would have been obvious to modify the combined system of Auerbach and Kim to include the steps of sending a message to an IM database indicating the corresponding user is online and the current IP address in order to more accurately track user relationships and maintain knowledge of the users and processes on the system. Therefore, the limitations would have been an obvious modification to the combines system of Auerbach and Kim.

In considering claim 18, the combined system of Auerbach, Kim, and Appelman discloses wherein the step of determining the current IP address comprises retrieving the address from the IM database (see Kim col. 4, lines 56-61).

In considering claim 19, Auerbach discloses sending a connection request from the first to the second device for establishing the instant message session (see Auerbach col. 11, lines 48-50).

In considering claim 20, Auerbach discloses generating a response to the connection request by the second device accepting the connection request (see Auerbach col. 11, lines 1-3).

In considering claim 103, Auerbach discloses displaying the window with a message area the message area being used to indicate messages between users (see Appelman Fig. 9)

Conclusion

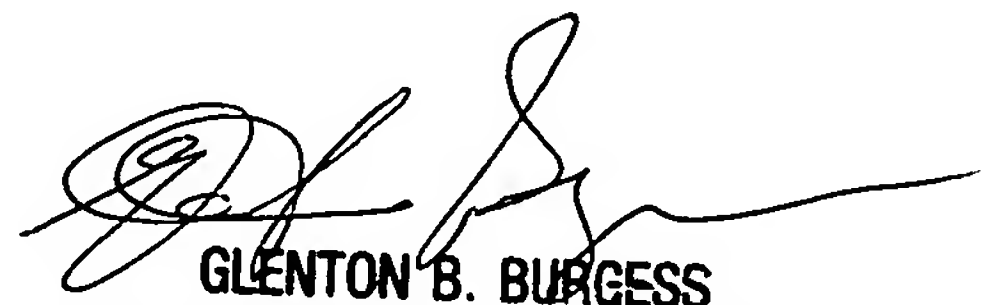
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly D Flynn whose telephone number is 571-272-3954. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 703-305-4792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kimberly D Flynn
Examiner
Art Unit 2153

KDF


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